



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
|-----------------|-------------|----------------------|---------------------|

09/058,496 04/10/98 MICHAUD J 07844/273001

TM02/0131

ROGER S BOROVY
FISH & RICHARDSON
SUITE 100
2200 SAND HILL ROAD
MENLO PARK CA 94025

EXAMINER

BASHORE, W

ART UNIT PAPER NUMBER

2176

DATE MAILED: 01/31/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

| | |
|--------------------------------|--------------------------------|
| Application No. 09/058,496 | Applicant(s) Michaud et al. |
| Examiner William L. Bashore | Group Art Unit 2176 |

Responsive to communication(s) filed on Nov 30, 2000

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

Claim(s) 1-10, 12, 13, and 15-28 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

Claim(s) _____ is/are allowed.

Claim(s) 1-10, 12, 13, and 15-28 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 6, 13

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2176

DETAILED ACTION

1. This action is responsive to communications: CPA and amendment filed on 11/13/2000 to the original application filed on 4/10/1998. IDS filed on 7/19/1999, and 11/30/2000. No priority or provisional filing date is claimed.
2. The rejection of claims 1-11, 13-14, 17-20, 22-23, 26-27 under 35 U.S.C. 103(a) as being unpatentable over Mapedit has been withdrawn as necessitated by amendment.
3. The rejection of claims 12, 21 under 35 U.S.C. 103(a) as being unpatentable over Mapedit and Carey has been withdrawn as necessitated by amendment.
4. The rejection of claims 15-16, 24-26 under 35 U.S.C. 103(a) as being unpatentable over Mapedit and Nielsen has been withdrawn as necessitated by amendment.
5. Upon further consideration, the examiner has now considered the Macromedia reference, and has included a revised PTO 1449 (paper 6) indicating said consideration.
6. Claims 1-28 are currently pending in this case. Claims 11, 14 have been canceled. Claim 28 has been added. Claims 1 and 5 are independent claims.

Continued Prosecution Application

7. The request filed on 11/13/2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/058,496 is acceptable and a CPA has been established. An action on the CPA follows.
8. This application filed under former 37 CFR 1.60 lacks the necessary reference to the prior application. A statement reading "This is a continuation of Application No. 09/058,496, filed April 10,

Art Unit: 2176

1998." should be entered following the title of the invention or as the first sentence of the specification.

Also, the current status of all nonprovisional parent applications referenced should be included.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. **Claims 12, 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

In regard to dependent claim 12, the phrase "*The method of claim 11*" is indefinite because applicant has canceled claim 11. The examiner's suggestion of changing said phrase to "*The method of claim 1*" will overcome this rejection.

In regard to dependent claim 15, the phrase "*The method of claim 14*" is indefinite because applicant has canceled claim 14. The examiner's suggestion of changing said phrase to "*The method of claim 1*" will overcome this rejection.

Art Unit: 2176

Examiner's Notes

For the following set of rejections, the examiner interprets dependent claim 11 as directly dependent upon claim 1, and interprets claim 15 as directly dependent upon claim 1.

Claim Rejections - 35 USC § 103

11. **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 1-10, 13, 17-20, 22-23, 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mapedit Imagemap Editing Software (hereinafter Mapedit), Version 2.3 for Windows 3.1, 1997 by Boutell.Com, Inc. URL: <http://www.boutell.com/mapedit>, pp.1-19.**

In regard to independent claim 1, Mapedit teaches image mapping of a selected file (Mapedit Figure 9 paragraph 1,2). Mapedit does not specifically teach the inputting of a graphic file containing layers. However, Mapedit teaches the saving of edited overlapping layered image regions (Mapedit Figures 17-19; compare with amended claim 1 “*receiving an electronic artwork having a plurality of layers, each layer having transparency information*”). It would have been obvious to one of ordinary skill in the art at the time of the invention to input said image mapped graphic, because of Mapedit’s taught advantage of reopening and editing such files.

Art Unit: 2176

Mapedit teaches user selection of a layer, and Mapedit teaches an image containing non-transparent, as well as transparent layers within an image (Mapedit Figures 17, 18; compare with amended claim 1 “*receiving from a user an input selecting a layer in an electronic artwork having a plurality of layers, the selected layer having content consisting of one or more non-transparent regions in a transparent frame* ”).

Mapedit teaches a method whereby areas of a graphic file are portioned, with a specific URL assigned to each portion so as to activate a URL when an area is selected, and Mapedit teaches a non-transparent region defining a hot spot region (Mapedit Figures 4, 5, 10, 17, 18; compare with amended claim 1 “*...calculating a definition of an area corresponding to a boundary of the one or more non-transparent regions in combination, and assigning an action to the area, the action defining a function that is to be activated when the area is selected.* ”).

Mapedit teaches a method of an image map, whereby a selected region (area) is selected, resulting in an action mapped from said region corresponding to a portion of an image (Mapedit Figure 17; compare with amended claim 1 “*associating the area and the action with the selected layer as a property of the selected layer in the electronic artwork* ”).

In regard to dependent claim 2, Mapedit teaches a method of assigning a URL to a selected region (Mapedit Figure 5; compare with claim 2).

In regard to dependent claim 3, Mapedit teaches compositing of images (Mapedit Figure 17; compare with claim 3 “*compositing the layers of the artwork* ”).

Art Unit: 2176

In addition, Mapedit teaches a method of converting a hotspot area along with associated URLs to an HTML file format (Mapedit Figure 16; compare with claim 3 “*converting the area and the action to a target output format.*”).

In regard to dependent claim 4, Mapedit teaches a method of converting a hotspot area along with associated URLs to an HTML file format (Mapedit Figure 16; compare with claim 4).

In regard to independent claim 5, Mapedit teaches image mapping of a selected file (Mapedit Figure 9 paragraph 1,2). Mapedit does not specifically teach the inputting of a graphic file containing layers. However, Mapedit teaches the saving of edited overlapping layered image regions (Mapedit Figures 17-19; compare with claim 5 “*receive an electronic artwork having a plurality of layers, each layer having transparency information*”). It would have been obvious to one of ordinary skill in the art at the time of the invention to input said image mapped graphic, because of Mapedit’s taught advantage of reopening and editing such files.

Mapedit teaches user selection of a layer (Mapedit Figures 17, 18; compare with claim 5 “*receive from a user an input selecting one of the plurality of layers*”).

Mapedit teaches a method whereby areas of a graphic file are portioned, with a specific URL assigned to each portion so as to activate a URL when an area is selected (Mapedit Figures 4, 5, 10; compare with claim 5 “*identify a non-transparent region of the selected layer of the electronic artwork; and assign an action to an area corresponding to the non-transparent region, the action defining a function that will be activated when the area is selected*”).

Art Unit: 2176

In regard to dependent claim 6, Mapedit teaches a method of creating a polygon-shaped area on a graphics file by creating boundaries via a mouse, said boundaries created until an enclosed polygon is created (Mapedit Figure 10; compare with claim 6 “*calculating a boundary of the non-transparent region*”).

In addition, Mapedit teaches a method whereby the area within said enclosed polygon reverses color when subsequently activated via said mouse (Mapedit Figures 5, 12; compare with claim 6 “*calculate a definition of the area from the boundary*.”).

In regard to dependent claims 7 and 8, claims 7 and 8 reflect the computer program product comprising computer readable instructions used for implementing the methods as claimed in claims 3 and 4, respectively, and are rejected along the same rationale.

In regard to dependent claim 9, Mapedit teaches a method whereby a mapped image is presented (Mapedit Figure 17). Mapedit does not specifically teach the saving of a composited image as an image file. However, since Mapedit teaches the presentation and saving of an image with different mapped layers, with both said image and said layers reproducible within the Mapedit editor environment, it would have been obvious to one of ordinary skill in the art at the time of the invention to save said layers as an image file, because of Mapedit’s taught advantage of the presentation and saving of layers with images.

In addition, Mapedit teaches a method of saving an HTML file including an associated graphics file and a hotspot with associated URLs (Mapedit Figures 2, 16; compare with claim 9 lines 4-6).

Art Unit: 2176

In regard to dependent claim 10, claim 10 incorporates substantially similar subject matter as claimed in amended claim 1, and is rejected along the same rationale.

In regard to dependent claim 13, Mapedit teaches the calculation of dynamic content for a selected layer before the area is calculated, since it is known in the art that currently edited information is considered dynamic information until saved, Mapedit's calculation and formulation of hotspots is based upon dynamic content, prior to saving.

In regard to dependent claim 17, Mapedit teaches a method whereby a hole is created subsequent to the creation of three imagemap shapes, said hole can be ignored by selecting delete from the default URL box so that no action is performed subsequent to the activation of said hole (Mapedit Figure 15; compare with claim 17).

In regard to dependent claim 18, Mapedit teaches a method whereby a hole is created subsequent to the creation of three imagemap shapes, said hole is designated as a hotspot region by selecting a default URL from the default URL box so that an action is performed subsequent to the activation of said hole (Mapedit Figure 15; compare with claim 18 "*separate regions having no holes are created if the region has holes*").

In addition, Mapedit teaches a method whereby the imagemaps created during a user session, including default regions (holes), are collectively used to define an imagemap of a graphical image (Mapedit Figure 15; compare with claim 18 "*the separate regions in combination contribute to the definition of the area.*").

Art Unit: 2176

In regard to dependent claims 19-20, 22-23, 26-27, claims 19-20, 22-23, 26-27 reflect the computer program product comprising computer readable instructions used for implementing the methods as claimed in claims 10-11, 13-14, 17-18, respectively, and are rejected along the same rationale.

13. Claims 12, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mapedit as applied to claims 1 and 5 above, and further in view of White et al. (hereinafter White), U.S. Patent No. 6,034,689 issued March 2000.

In regard to dependent claim 12, Mapedit teaches a method whereby areas of edited graphic file are portioned with a specific URL assigned to each bounded portion so as to activate a URL when an area is selected, said area of bounded portion displayed in reverse color when activated (Mapedit Figures 4, 5, 10). Mapedit does not specifically teach a method of conforming the area automatically to content of the selected layer subsequent to editing of said layer. However, White teaches the rescaling of an image map area subsequent to the resizing of a web page to fit different display areas (White column 15 lines 24-37; compare with claim 12 "*conforming the area automatically to content of the selected layer*"). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the method of White to the method of Mapedit, because of White's taught advantage of scaling, providing a way for preserving an image map subsequent to changes in size of the the edited imagemap method as taught by Mapedit.

Art Unit: 2176

In regard to dependent claim 21, claim 21 reflects the computer program product comprising computer readable instructions used for implementing the method as claimed in claim 12, and is rejected along the same rationale.

14. **Claims 15-16, 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mapedit as applied to claims 1 and 5 above, and further in view of Nielsen, U.S. Patent No. 5,991,781 issued November 1999.**

In regard to dependent claim 15, claim 15 incorporates substantially significant subject matter as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Mapedit teaches multiple hot spot regions within an image (Mapedit Figure 5; compare with claim 15 “*the selected layer has two or more non-contiguous*”, and “*...in a transparent frame*”). Mapedit does not specifically teach the inclusion of two or more non-transparent regions. However, Nielsen teaches at least two non-transparent regions (Nielsen Figures 1b, 11; compare with claim 15 “*...non-transparent...*”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the method of Nielsen to the method of Mapedit, because of Nielsen’s taught advantage of non-transparent images, providing an alternate way to show regions within an image.

In addition, Mapedit teaches multiple hot spot regions within an image, said regions can encompass the entire image (Mapedit Figure 5; compare with claim 15 “*the non-transparent regions in combination define the area.*”).

Art Unit: 2176

In regard to dependent claim 16, claim 16 incorporates substantially significant subject matter as claimed in claim 15, and in further view of the following, is rejected along the same rationale.

Mapedit teaches a method whereby multiple image maps can be defined in different areas of an image (Mapedit Figure 4; compare with claim 16 line 2, “*generating multiple image maps*”).

In regard to dependent claims 24-25, claims 24-25 reflect the computer program product comprising computer readable instructions used for implementing the methods as claimed in claims 15-16, respectively, and are rejected along the same rationale.

15. **Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mapedit as applied to claim 1 above, and further in view of Habermehl, U.S. Patent No. 5,956,701 issued September 1999.**

In regard to dependent claim 28, Mapedit does not specifically teach calculating a hot spot area by utilizing the tracing of boundary perimeters. However, Habermehl teaches defining hot spot areas taking into account the boundaries of an area, said defining accomplished via neural net (Habermehl column 3 lines 35-40, Figures 3, 6; compare with claim 28). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Habermehl to Mapedit, because of Habermehl’s taught advantage of calculating areas, providing a way for defining portions of an image using fewer inputs and less redundancy to Mapedit (Habermehl column 2 lines 59-61).

Art Unit: 2176

Response to Arguments

16. Since no arguments have been presented by the applicant, no rebuttal by the examiner is deemed necessary at the present time.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to disclosure.

| | | | |
|-----------------|---------------------------|--------|-----------|
| Marimont et al. | U.S. Patent No. 5,751,852 | issued | May 1998 |
| Adapathy et al. | U.S. Patent No. 6,075,537 | issued | June 2000 |

NCSA Imagemap Tutorial, web page downloaded from Internet: [<URL: <http://hoohoo.ncsa.uiuc.edu/docs/tutorials/imagemapping.html>>], November 5, 1995, downloaded 1/23/2001, pp.1-4.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Bashore whose telephone number is **(703) 308-5807**. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on **(703) 308-5186**. The fax number to this art unit is **(703) 308-6606**.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(703) 305-3900**.

Art Unit: 2176

19. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

or:

(703) 305-9724 (for informal or draft communications, please label
“PROPOSED” or “DRAFT”)

**Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA, Sixth Floor (Receptionist).**

William L. Bashore
1/22/2001



STEPHEN S. HONG
PRIMARY EXAMINER